

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants:	FINE, et al.	Patent Application
Application No.:	10/797,785	Group Art Unit: 3624
Filed:	March 8, 2004	Examiner: Jarret, Scott L.
For:	SYSTEM AND METHOD FOR FINANCE FORECASTING	

REPLY BRIEF

In response to the Examiner's Answer mailed on May 5, 2010, Appellants respectfully submit the following remarks.

### REMARKS

Appellants are submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellants are addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellants agree with the other arguments presented in the Examiner's Answer.

#### Examiner's Answer page 13 lines 3-7

The Examiner's Answer states on page 13 lines 3-7, "Applicant's argues that the prior art of record teaches away from one another ... and therefore there is no motivation to combine the references..." Appellants respectfully submit that because Kaplan and Sarin teach away from each other, there is no motivation to combine Kaplan with Sarin. Further, since Kaplan and Plott-MIG teach away from each other, Kaplan and Plott-IAM teach away from each other, Sarin and Plott-MIG teach away from each other, and Sarin and Plott-IAM teach away from each other, Plott-IAM and Plott-MIG cannot be relied upon for motivation to combine Kaplan and Sarin. Further, there would be no motivation to combine either Plott-IAM or Plott-MIG with Kaplan or Sarin if a future office action would be so inclined.

#### Examiner's Answer second paragraph on page 13

The Examiner's Answer states on the second paragraph on page 13, "Examiner notes that Applicants do not argue that the applied references do not teach the claimed elements of the instant application, instead the thrust of Applicant's arguments are that the prior art of record teaches away form each other and therefore there is no motivation to combine the applied prior art references."

The Office Action asserts that the combination of Kaplan and Sarin render Claims 1, 3-6, 8-14 and 17-23 obvious. However, Appellants respectfully submit that it is improper to combine two pieces of art that teach away from each other when considered as a whole (MPEP 2145(X)(D)(2) and MPEP 2141.02(VI)). Since, Appellants understand Kaplan and Sarin to teach away from each other. Appellants

respectfully submit that there is no motivation to combine Kaplan and Sarin to render any embodiment obvious.

Examiner's Answer fifth from last line on page 13 to first line on page 14.

The Examiner's Answer states starting at the fifth from last line on page 13 to third line on page 14,

Plott-IAM and Plott-MIG are recited on page 8 of the Final office action mailed October 20, 2009, but this citation was merely to reinforce examiner's assertion that probability bins are old and well known as first provided to the applicant in the Non-Final Office Action mailed May 21, 2009 (Bullets 1-2, Page 8) to provide support for the officially cited fact that it is old and very well known to provide probabilities for various expected outcomes (i.e., probability bins as claimed).

Appellants respectfully reiterate that Plott-IAM and Plott-MIG cannot be relied on for that which is old and very well known or for providing motivation to combine because they teach away from the combination under MPEP 2145(X)(D)(2) and MPEP 2141.02(VI). Appellants have been arguing that Plott-IAM and Plott-MIG teach away from Kaplan and Sarin from the first time that they appeared in an Office Action, which was the Office Action mailed May 21, 2009.

Examiner's Answer page 14 lines 1-3.

The Examiner's Answer states on page 14 lines 1-3, "Examiner notes that three additional references were also cited in the office action mailed May 21, 2009 to provide for this officially cited fact (Last Three Bullets, Page 7)." Appellants respectfully submit that it appears in the last 7 bullets on page 7 that the Office Action is relying on Kaplan instead of "three additional references." For example, in the sentence preceding the last three bullets on page 7, the Office Action states, "Regarding Claims 1, 10, 19 and 22 Kaplan teaches a method and system for forecasting comprising..." If the Office Action's intent was to rely on other art on page 7, the Office Action did not make this clear.

Examiner's Answer on page 14 lines 4-5

The Examiner's Answer states on page 14 lines 4-5, "Ultimately only Sarin was relied upon for teaching 'probability bins'..." Appellants respectfully submit that there is no motivation to combine Sarin with Kaplan because Sarin and Kaplan teach away from each other as discussed herein and in the appeal brief, among other places.

Examiner's Answer starting at the second to last line on page 14 through page 15 line 1.

The Examiner's Answer states at the second to last line on page 14 through page 15 line 1, "Initially it is noted that whether the participants are or are not 'experts' is moot as the currently pending claims, nor in the Applicant's specification, is there any requirement for a participant to have or not have a specific level of skill or expertise."

Appellants respectfully submit that MPEP 2145(X)(D)(2) clearly states that "[i]t is improper to combine references where the references teach away from their combination." Appellants respectfully note that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Further, "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed amendment" (emphasis added) (MPEP 2143.01(V); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Appellants are arguing that there is no motivation to combine the teachings of Kaplan and Sarin because they teach away from each other.

When considering both Sarin and Kaplan as a whole, as required by MPEP 2141.02(VI), Sarin requires "experts" to provide their opinions (abstract), whereas, Kaplan teaches away from using experts (Col. 1 lines 60-65, Col. 4 lines 3-17, Col. 4 lines 63-65). Therefore, when considering both Sarin and Kaplan as a whole, including those portions which teach away, Appellants respectfully submit that Sarin and Kaplan

teach away from each other. Therefore, there is no motivation to combine Sarin and Kaplan.

Examiner's Answer page 15 lines 2-4

The Examiner's Answer states at page 15 lines 2-6, "Additionally this non-recited expertise level or lack thereof in the information market does not fundamentally affect the workings of the market..."

Appellants respectfully submit that both Kaplan and Sarin teach that the level of expertise does matter. Since Kaplan teaches away from using experts (Col. 1 lines 60-65, Col. 4 lines 3-17, Col. 4 lines 63-65) and Sarin requires experts (abstract), Kaplan and Sarin teach away from each other. Therefore, there is no motivation to combine Kaplan and Sarin.

Examiner's Answer page 15 lines 4-6

The Examiner's Answer page 15 lines 4-6 states "nor would one skilled in the art at the time of the invention or understand that an information market with expert and/or non-expert participants would work fundamentally in the same manner."

Appellants respectfully submit that the Office Action has relied on Kaplan and Sarin for evidence of what one of ordinary skill in the art would have known at the time of the invention and what would have motivated one of ordinary skill in the art at the time of the invention. Since Kaplan teaches away from using experts (Col. 1 lines 60-65, Col. 4 lines 3-17, Col. 4 lines 63-65) and Sarin requires experts (abstract), Kaplan and Sarin teach away from each other. Therefore, there is no motivation to combine Kaplan and Sarin.

Examiner's Answer page 15 lines 11-22

Appellants respectfully submit that since Kaplan and Plott-MIG teach away from each other, Kaplan and Plott-IAM teach away from each other, Sarin and Plott-MIG teach away from each other, and Sarin and Plott-IAM teach away from each other,

Plott-IAM and Plott-MIG cannot be relied upon for motivation to combine Kaplan and Sarin. Further, there would be no motivation to combine either Plott-IAM or Plott-MIG with Kaplan or Sarin if a future office action would be so inclined.

Examiner's Answer first paragraph of first two paragraphs of page 16

Appellants respectfully submit that there is no motivation to combine or modify two pieces of art, such as Kaplan and Sarin, when considered as a whole, those two pieces of art teach away from each other. Further, the question of whether Kaplan and Sarin are analogous art is moot since Kaplan and Sarin teach away from each other. With regards to "The claimed invention is merely a combination of the old elements of Kaplan and Sarin and in the combination each element would merely have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable," Appellants respectfully submit that the elements would not perform the same function since Sarin's elements require an expert and Kaplan's elements rely on non-experts. Further, based on the guidelines set forth by the MPEP for determining what one of ordinary skill in the art would have recognized, one of ordinary skill in the art would not have recognized that the results of the combination were predictable because Sarin and Kaplan teach away from each other.

Examiner's Answer page 16 last paragraph through page 17 line 3.

Appellants respectfully submit that MPEP 2145(X)(D)(2) and MPEP 2141.02(VI) clearly provides the guidelines for determining whether one of ordinary skill in the art would be motivated to combine references. In other words, there is no motivation to combine two pieces of art, when considered as a whole, those two pieces of art teach away from each other. Appellants have clearly demonstrated that Kaplan and Sarin teach away from each other. Therefore, there is no motivation to combine Kaplan and Sarin to render any embodiments obvious.

Examiner's Answer page 17 second paragraph

The Examiner's Answer states in the second paragraph on page 17, "Applicant's arguments fail to comply with 37 CFR 1.11(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references."

Appellants respectfully traverse. Appellants arguments are not general allegations. Appellants have pointed to portions of Sarin and Kaplan that teach away from each other. More specifically Sarin teaches that Sarin requires experts in the abstract and Kaplan teaches away from experts at Col. 1 lines 60-65, Col. 4 lines 3-17, Col. 4 lines 63-65. Therefore, Appellants arguments are not unfounded general allegations.

Concerning to "pointing out how the language of the claims patentably distinguishes them from the references," Appellants respectfully submit that the Office Action has relied on the combination of Kaplan and Sarin. However, when considering Kaplan as a whole and when considering Sarin as a whole, Kaplan and Sarin teach away from each other.

Examiner's Answer third paragraph on page 17

The Examiner's Answer states at the third paragraph on page 17, "Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty..." Novelty pertains to 35 U.S.C. 102. Non-obviousness pertains to 35 U.S.C. 103. Appellants respectfully submit that the Office Action rejected embodiments under 35 U.S.C. 103 not 35 U.S.C. 102. Appellants are required under 35 U.S.C. 102 to point out novelty. However, motivation to combine is required for 35 U.S.C. 103 and if two pieces of art teach away from each other when considered as a whole including those portions which teach away, then there is no motivation to combine those two pieces of art.

Examiner's Answer last paragraph of page 17

Appellants respectfully disagree. An example of arguing Kaplan and Sarin individually would be arguing that Kaplan does not teach element 2 and Sarin does not teach element 1 when the Office Action has asserted that Kaplan teaches element 1 and Sarin teaches element 2. However, this is not what Appellants did. Instead, Appellants have argued that when considering Kaplan as a whole and when considering Sarin as a whole, Kaplan and Sarin teach away from each other. Therefore, Appellants have not argued Kaplan and Sarin individually.



### CONCLUSION

In view of the above remarks, Appellants continue to assert that Claims 1, 3-6, 8-14 and 17-23 are patentable over Kaplan in view of Sarin. Appellants continue to assert that Claims 6, 7, 15 and 16 are patentable over Kaplan in view of Sarin and further in view of "Long Term Forecasting" and still further in view of Pennock. Appellants continue to assert that Claim 24 is patentable over Kaplan in view of Sarin and further in view of "Long Term Forecasting" and still further in view of Lundgren.

Respectfully submitted,

WAGNER BLECHER LLP

Dated: 07/06/2010

/John P. Wagner, Jr./  
John P. Wagner, Jr.  
Registration Number: 35,398

WAGNER BLECHER LLP  
123 Westridge Drive  
Watsonville, CA 95076  
(408) 377-0500